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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,482	11/13/2001	Hiroyoshi Kishi	35.G1972 Div. I	6512

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NEW YORK, NY 10112

EXAMINER

KHARE, DEVESH

ART UNIT PAPER NUMBER

1623

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,482

Applicant(s)

KISHI ET AL.

Examiner

Devesh Khare

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10 and 12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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The remarks and request for RCE filed on 04/02/2004, is acknowledged. Claims 1, 7 and 12 have been amended. Claims 8 and 11 have been cancelled. Claims 1-7,9,10 and 12 are currently pending in this application. In view of the amendments which clarify the extent of crosslinking in the glycopolymers of the present invention, the examiner withdraws the 35 U.S.C. 103(a) rejections as obvious over Iritani et al., because the glycopolymers of the present invention are cross-linked and there is no disclosure of any such crosslinking in the compounds of Iritani et al. reference.

35 U.S.C. 112, second paragraph rejection

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7,9,10 and 12 are rejected under the second paragraph of 35 U.S.C. 112, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) The phrase "a decomposable bond" in claim 1 is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

(B) Regarding claims 1,7 and 12 the phrase "to the extent" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

(C) Claims 1, 6 and 12 are vague and indefinite. Claims 1, 6 and 12 fail to particularly point out the identity of the "second component" or "compound having a vinyl group".

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Claims which depend from an indefinite claim which fail to obviate the indefiniteness of the claim from which they depend are also seen to be indefinite and are also rejected for the reasons set forth supra.

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7,9,10 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,2,7,8 ,12-15, 20 and 21 of U.S. Patent No. 6,316,606 ('606).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the '606 patent claims a glycopolymer of a saccharide having glucopyranose rings and a second component wherein the glycopolymer may contain molecular chain having at least one type of repeating unit, where chains are crosslinked by a saccharide or with a bifunctional or polyfunctional aliphatic compound wherein said glycopolymers are encompassed by or has substantial overlap with the glycopolymers of the instant claims. The glycopolymers or copolymers are drawn of having a repeating

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unit consist of a saccharide component and a bifunctional compound (second component) wherein bifunctional compound is a diamine or a dicarboxylic acid. It is noted that the '606 patent discloses that a material having a functional group can be cross-linked by the oligosaccharide (col.7, lines 32-34) and the glycopolymers are cross-linked (col.8, lines 10-14). However, the instant crosslinked glycopolymers, containing a repeating unit, which is comprised of:

(1) a saccharide consisting of glucopyranose
(2) a bifunctional or polyfunctional aliphatic compound consisting of a dicarboxylic acid, a diol, a diamine and a diisocyanate, which is the underlying glycopolymers or copolymers having a repeating unit consist of a saccharide component and a bifunctional compound (second component) wherein bifunctional compound is a diamine or a dicarboxylic acid by which the glycopolymers of the issued claims are accomplished. It would be obvious to select the copolymers set forth in the claims of the issued patent and modify them to obtain crosslinked glycopolymers, containing a repeating unit, which is comprised of:

(1) a saccharide consisting of glucopyranose
(2) a bifunctional or polyfunctional aliphatic compound consisting of a dicarboxylic acid, a diol, a diamine and a diisocyanate.

The examiner notes the instant claims and the '606 claims do indeed substantially overlap and this obviousness-type double patenting rejection is necessary to prevent

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the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

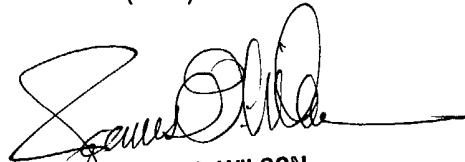
Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Devesh Khare whose telephone number is (571)272-0653. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, Supervisory Patent Examiner, Art Unit 1623 can be reached at 571-272-0661. The official fax phone numbers for the organization where this application or proceeding is assigned is (703) 308-4556 or 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Devesh Khare, Ph.D.,J.D.
Art Unit 1623
June 10,2004



JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1800